

Remarks

This communication is considered fully responsive to the Office Action. Claims 1, 7-10, 13-15, and 18 were examined. Claims 1, 7-10, 13-15, and 18 stand rejected. Claims 8, 9, and 14 are amended. No claims are currently canceled. Reexamination and reconsideration of the pending claims are respectfully requested.

Claim Objections

The Office Action objected to claims 7, 13, and 18 as reciting “a graphical association designation,” while the specification only discusses “an association designation.” Applicant respectfully notes that the specification as originally filed includes support for a “graphical association designation.” See, e.g., paragraph [0047] in the published patent application which states:

Such a designation may comprise, for example, a visible icon provided in a corner of the viewed image that indicates to the user that the image was extracted from a multi-mode image file (i.e. a video file). Alternatively, the designation can comprise an asterisk or other indicator that is added to the filename of the still image file that will be visible when the filename is shown to the user (e.g., in the storage directory).

The Office Action also objected to claims 8, 9 and 14 because each of these dependent claims only refers to “an association designation.” Applicant appreciates the Examiner noting this typographical error and these claims have been amended accordingly.

Claim Rejections - 35 U.S.C. 102(a)

The Office Action rejected claims 1 and 10 under 35 U.S.C. 102(a) as being anticipated by Applicant’s Background section in the specification of the patent application (“Applicant’s Background”). Applicant respectfully traverses this rejection.

Claim 1 recites “identifying at least one of a filename or a storage location of the multi-mode image file” and “storing an indication of the at least one of a filename or a storage location of the multi-mode image file as metadata associated with the extracted relatively high-resolution image.” Claim 10 includes similar recitations which were rejected on the same basis as claim 1. Applicant’s Background fails to disclose at least these recitations.

The Office Action cites to the discussion of the hybrid solution also referred to as “multi-mode” operation in Applicant’s Background on page 2, lines 1-22, and then says the features recited in claim 1 would be inherent. By rejecting claims 1 and 10 as being inherently disclosed, the Office Action is admitting that the claim recitations are not expressly shown in the cited references. Applicant agrees with this admission. However, the Office Action erroneously relied on

inherency as the only evidence for rejecting these recitations in claims 1 and 10.

Applicant respectfully traverses this position.

In order to support a rejection based upon the inherent limitations that are not expressly disclosed in a prior art reference, more than a summary statement that the recitations are inherent is required. It must be shown that the undisclosed information was known by those of ordinary skill in the art to be present in the reference. *Rosco, Inc. v. Mirror Light Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002).

Applicant contends that the claim recitations are not inherent in the cited references or otherwise considered common knowledge to those having ordinary skill in the art. To the contrary, Applicant's Background goes on to discuss the shortcomings of the hybrid solution, e.g., at page 2, line 23 to page 3, line 8:

Although such multi-mode operation provides the user with greater flexibility in using captured image data, there currently is no mechanism for determining the origin of a given extracted still image. Therefore, if the user later comes across the extracted still image, the user may have no idea as to which multi-mode image file the image came from, or even whether the image was extracted from a multi-mode image file at all. Assuming that the user does realize that the image was extracted from a multi-mode image file, the user may need to manually review multiple stored video files before the origin of the extracted still image is located. This process is

inefficient and, if the user has many stored video files, can waste a large amount of time.

If this rejection is maintained on a similar basis in a subsequent action, Applicant respectfully requests the Examiner provide affidavit evidence beyond a mere conclusionary statement to support this modification of the cited reference. “When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee. . . .” 37 CFR §1.104(d)(2).

For at least the foregoing reasons claims 1 and 10 are believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claim Rejections - 35 U.S.C. 103(a)

The Office Action rejected claim 15 under 35 U.S.C. 103(a) as being unpatentable over Applicant’s Background in further view of Official Notice. Applicant respectfully traverses this rejection.

Claim 15 recites “logic configured to identify at least one of a filename or a storage location of a multi-mode image file . . .” and “logic configured to store an indication of the at least one of a filename or a storage location of the multi-mode image file as metadata associated with the extracted relatively high-resolution

image.” Applicant’s Background in view of Official Notice fail to teach or suggest at least these recitations.

Again, the Office Action cites to Applicant’s Background and states that the claim recitations would be inherent. Applicant believes this rejection is in error as discussed above for claims 1 and 10.

For at least the foregoing reasons claim 15 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 15.

The Office Action rejected claims 7-9 and 13-14 under 35 U.S.C. 103(a) as being unpatentable over Applicant’s Background in view of U.S. Patent Publication No. 2001/0015762 to Suzuki, et al. (“Suzuki”). Applicant respectfully traverses this rejection.

Claims 7-9 depend from independent claim 1 and claims 13-14 depend from independent claim 10. Independent claims 1 and 10 are believed to be allowable. Therefore, claims 7-9 and 13-14 are also believed to be allowable for at least the same reasons as the respective independent claims.

In addition, claim 7 further recites “adding a graphical association designation to the extracted relatively-high resolution image that indicates to a user that the extracted relatively high-resolution image was extracted from a multi-mode image file.” Claims 8 and 9 include further recitations directed to the “graphical association designation.” Claims 13 and 14 also include similar recitations and were rejected on a similar basis.

The Office Action explains that Suzuki “teaches an association designation to how a group of images taken are related using icons” and relies generally on Figures 3, 7, 9, and 11-18, and paragraph [0017] et seq.

First, Applicant does not understand what exactly is in these Figures or in paragraph [0017] that the Examiner interprets as being an association designation. As previously noted in response to the Objection, such a designation may comprise, for example, a visible icon provided in a corner of the viewed image that indicates to the user that the image was extracted from a multi-mode image file (*i.e.* a video file). Alternatively, the designation can comprise an asterisk or other indicator that is added to the filename of the still image file that will be visible when the filename is shown to the user (*e.g.*, in the storage directory). Applicant does not find any of these or anything else in Suzuki which can properly be construed as an association designation.

Second, Applicant believes the Examiner has misinterpreted Suzuki. Suzuki shows an image display frame area 23 and image display frames 32a-c (see, e.g., para. [0066]-[0067] stating that “the image display frames 32a, 32b, 32c provide a function of previewing each of the photographed images”). Suzuki also shows an image display area 21, a photographed button icon 22, a photographed image display frame area 23, a photographing mode menu 24, a display mode menu 25, and an environment setting menu 26 (see, e.g., para. [0061]). However, Applicant does not understand how any of these teach or suggest a graphical association designation to the extracted relatively-high resolution image that indicates to a

user that the extracted relatively high-resolution image was extracted from a multi-mode image file. Nor has the Examiner provided adequate explanation or reasoning to support such an interpretation.

Withdrawal of the rejection of claims 7-9 and 13-14 is respectfully requested for at least the foregoing reasons.

The Office Action rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background in view of Official Notice, and in further view of Suzuki. Applicant respectfully traverses this rejection.

Claim 18 depends from independent claim 15, which is believed to be allowable. Therefore, claim 18 is also believed to be allowable for at least the same reasons as claim 15.

In addition, claim 18 further recites "logic configured to add a graphical association designation to the extracted relatively-high resolution image that indicates to a user that the extracted relatively high-resolution image was extracted from a multi-mode image file, the association designation comprising at least one of an icon that is visible when the image of the separate still image file is viewed and an indicator to the filename of the separate still image file." Again, the Office Action relied on Suzuki as teaching these recitations. Applicant respectfully disagrees for the reasons set forth above with regard to claims 7-9 and 13-14.

Withdrawal of the rejection of claim 18 is respectfully requested for at least the foregoing reasons.

Conclusion

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

/Mark D. Trenner/

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Mark D. Trenner
Reg. No. 43,961
(720) 221-3708